

GP 1655  
#

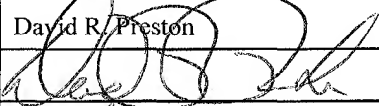
<b>TRANSMITTAL FORM</b> (to be used for all correspondence after initial filing)		Application Number:	09/648,081
		Filing Date:	August 25, 2000
		First Named Inventor:	Wang
		Group Art Unit:	1655
		Examiner:	Lu
Total Pages in This Submission:	4	Attorney Docket Number:	ART-00101.P.1


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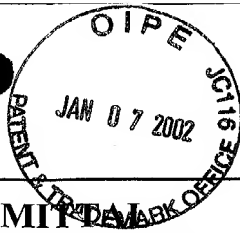
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ENCLOSURES (check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Assignment Papers (for an Application)	<input type="checkbox"/> After Allowance Communication to Group
<input checked="" type="checkbox"/> Fee Attached	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input checked="" type="checkbox"/> Amendment / Response	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Group (Appeal, Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition Routing Slip (PTO/SB/69) and Accompanying Petition	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits / Declarations(s)	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Status Letter
<input checked="" type="checkbox"/> Extension of Time Requests	<input type="checkbox"/> Power of Attorney, Revocation, Change of Correspondence Address	<input checked="" type="checkbox"/> Additional Inclosures, identified below:  Postcard
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Terminal Disclaimer	
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> Small Entity Statement	
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> Request for Refund	
<input type="checkbox"/> Response to Missing Parts / Incomplete Application	Remarks:	
<input type="checkbox"/> Response to Missing Parts under 37 C.F.R. 1.52 or 1.53		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual Name	David R. Preston
Signature	
Date	Nov 6, 2001

CERTIFICATE OF MAILING			
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on this date.			Date: 11/6/01
Typed or printed name:	David R. Preston		
Signature		Date:	11/6/01



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<b>FEE TRANSMITTAL</b> Patent fees are subject to annual revision on October 1. These are the fees effective October 1, 1997. Small Entity payments <u>must</u> be supported by a small entity statement, otherwise large entity fees must be paid. See Forms PTO/SB/09-12. See 37 C.F.R. §§ 1.27 and 1.28.		Complete if Known	
		Application Number:	09/648,081
		Filing Date:	August 25, 2000
		First Named Inventor:	Wang
		Group / Art Unit:	1655
<b>Total Amount of Payment</b>	<b>\$ 200.00</b>	Docket Number:	ART-00101.P.1

METHOD OF PAYMENT
1. <input type="checkbox"/> The Commissioner is hereby authorized to charge indicated fees and credit any over payments to: Deposit Account Number: <input type="checkbox"/> Deposit Account Name: <input type="checkbox"/> <input type="checkbox"/> Charge Any Additional Fee Required Under 37 C.F.R. §§ 1.16 and 1.17 to <u>Deposit Account Number 50132</u> <input type="checkbox"/> Charge the Issue Fee Set in 37 C.F.R. § 1.18 at the Mailing of the Notice of Allowance.
2. <input checked="" type="checkbox"/> Payment Enclosed <input checked="" type="checkbox"/> Check Number <u>1029</u> <input type="checkbox"/> Money Order <input type="checkbox"/> Other

FEE CALCULATION						
1. BASIC FILING FEE						
	Large Entity Fee Code	Large Entity Fee (\$)	Small Entity Fee Code	Small Entity Fee (\$)	Fee Description	Fee Paid
	101		201		Utility Filing Fee	\$
	106		206		Design Filing Fee	\$
	107		207		Plant Filing Fee	\$
	108		208		Reissue Filing Fee	\$
	114		214		Provisional Filing Fee	\$
<b>SUBTOTAL (1)</b>						<b>\$ 0.00</b>

## 2. EXTRA CLAIM FEES


				Extra Claims		Fee From Below		Fee Paid
Total Claims	[ ]	-20 **	Equals	[0]	Times	[ ]	Equals	\$ 0.00
Independent Claims	[ ]	-3 **	Equals	[0]	Times	[ ]	Equals	\$ 0.00
<b>Subtotal (2)</b>								\$ 0.00

\*\* or number previously paid, if greater, For Reissues, see below

	Large Entity		Small Entity		Fee Description
	Fee Code	Fee (\$)	Fee Code	Fee (\$)	
	103		203		Claims in excess of 20
	102		202		Independent claims in excess of 3
	104		204		Multiple dependent claim, if not paid
	109		209		** Reissue independent claims over original patent
	110		210		** Reissue claims in excess of 20 and over original patent

3. ADDITIONAL FEES					
Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
105		205		Surcharge - late filing fee or oath	\$
127		227		Surcharge - late provisional filing fee or cover sheet	\$
139		139		Non-English specification	\$
147		147		For filing a request for reexamination	\$
112		112		Requesting publication of SIR prior to Examiner action	\$
113		113		Requesting publication of SIR after Examiner action	\$
115		215		Extension for reply within first month	\$
116		216	200.00	Extension for reply within second month	\$ 200.00
117		217		Extension for reply within third month	\$
118		218		Extension for reply within fourth month	\$
128		228		Extension for reply within fifth month	\$
119		219		Notice of Appeal	\$
120		220		Filing a brief in support of an appeal	\$
121		221		Request for oral hearing	\$
138		138		Petition to institute a public use proceeding	\$
140		240		Petition or revive - unavoidable	\$
141		241		Petition or revive - unintentional	\$
142		242		Utility issue fee (or reissue)	\$
143		243		Design issue fee	\$
144		244		Plant issue fee	\$
122		122		Petitions to the Commissioner	\$
123		123		Petitions related to provisional applications	\$
126		126		Submission of Information Disclosure Statement	\$
581		581		Recording each patent assignment per property	\$
146		246		Filing a submission after final rejection (37 C.F.R. 1.129(a))	\$
149		249		For each additional invention to be examined (37 CFR 1.129(b))	\$
Other fee (specify):					\$
Subtotal (3)					\$ 200.00

4. SUMMATION OF FEES	
SUBTOTAL (1)	\$ 0.00
SUBTOTAL (2)	\$ 0.00
SUBTOTAL (3)	\$ 200.00
<b>TOTAL FEES</b>	<b>\$ 200.00</b>

SUBMITTED BY			Complete (If Applicable)	
Typed or Printed Name	David R. Preston		Registration Number:	38,710
Signature		Date: 4/6/01	Deposit Account User ID Number	50132



Patent

Attorney Docket No: ART-00101.P.1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Wang et al.

Application Number: 09/648,081

Filed: August 25, 2000

For: METHODS AND  
COMPOSITIONS FOR IDENTIFYING  
NUCLEIC ACID MOLECULES USING  
NUCLEOLYTIC ACTIVITIES AND  
HYBRIDIZATION

Examiner: Lu, Frank W.

Group Art Unit: 1655

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Assistant Commissioner for Patents  
Washington D.C., 20231

Sir,

### RESPONSE TO RESTRICTION REQUIREMENT

In response to the Office Action mailed August 28, 2001, Applicants submit the following election and traverse. Applicants submit this response within three months of that mailing date. Thus, a two month's extension of time is deemed appropriate and the fee of \$200.00 is included herewith and such extension is respectfully requested. Accordingly, this Response is timely filed.





In the Office Action, the Examiner restricts the claims to four distinct and independent inventions. For the following reasons, Applicants traverse this restriction requirement.

B. Standard for Restriction

The M.P.E.P. (Feb. 2000) sets forth the standard for restriction requirements.

There are two criteria for a proper requirement for restriction between patentably distinct intentions:

- A. The inventions must be independent (see M.P.E.P. §802.01, §806.04, §808.01) or distinct as claimed (see M.P.E.P. §806.05 - §806.05(i); and
  - B. There must be a serious burden to the examiner if restriction is not required (see M.P.E.P. §803.02, §806.04(a) - (j), §808.01(a) and §808.02)
- M.P.E.P. § 803 (Feb. 2000)

The term "independent" (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect, for example: (1) species under a genus which species are not useable together as disclosed or (2) process and apparatus incapable of being used in practicing the process.

M.P.E.P. § 802.01 (Feb. 2000).

B. The Claims

The claims of Groups I through III, while being patentably distinct, do not require restriction as they are connected by a single, searchable unifying relationship that connects the claims in design. M.P.E.P. § 802.01 (Feb. 2000). Because of the single, searchable unifying relationship, the Examiner would not be seriously burdened by searching and examining the claims together in a single application.

The claims are connected by a single searchable unifying relationship, namely methods that share similar method steps that utilize nucleolytic activity and which have been classified by

the USPTO in the same class and subclass, namely 435/6. This unifying relationship connects the claims of the groups in design. The single searchable unifying element can be primarily searched by electronically searching key words or, for example, by the common classification.

Because the claims of Groups I through III are patentably distinct, are not independent and are connected by a single searchable unifying element, the Examiner would not be seriously burdened by examining these claims together. Accordingly, Applicants request that the Examiner join the claims of Groups I through III. In the alternative, Applicants request that the Examiner join the claims of Groups I and III.


### III. CONCLUSION

Based on the commonality of the subject matter of the amended claims, Applicants request that the Examiner join the claims of Groups I through III, or in the alternative join the claims of Groups I and III, into a single group. For completeness, Applicants have elected the claims of Group I for examination. Applicants respectfully submit that the claims are ready for examination and in condition for allowance.

Please apply any charges not covered, or any credits, to **Deposit Account Number 501321** in the name of David R. Preston & Associates, having **Customer Number 24232**.

Respectfully submitted,

Date: Nov 6, 2001



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Reg. No. 38,710

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